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10/803,644	03/18/2004	Hiroyasu Nishimura	SUZ-34	5345
20311 7590 09/16/2008 LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016				
EXAMINER				
PARK, CHAN S				
ART UNIT		PAPER NUMBER		
2625				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/803,644

## Applicant(s)

NISHIMURA ET AL.

## Examiner

CHAN S. PARK

## Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's amendment was received on 6/5/08, and has been entered and made of record. Currently, **claims 1-12** are pending.

***Specification***

2. The corrected or substitute specification was received on 6/5/08. The specification is acceptable.

***Drawings***

3. The corrected or substitute drawings were received on 6/5/08. The drawings are acceptable.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

***Response to Arguments***

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**With respect to claim 1**, it recites the limitation of "inputted image information" in line 11. It is unclear if this limitation is referring to the image information recited in line 2, line 5 or line 6? Or are they the same? If they are the same, would there ever be any differences among them? Which of them is not the inputted image information? Don't they have to be inputted first in a particular location in order to output, convert and store? Clarification/explanation from the Specification is respectfully requested.

Furthermore, Claim 1 recites the limitation of "said printing unit outputting the image information... as an image on the basis of the printing information" in lines 23-27. It is unclear if this printing information is referring to the printing information recited in lines 21-22 or lines 18-19.

**With respect to claim 2**, it recites the limitation of "said printing unit outputting the image information... as an image on the basis of the printing information" in lines 8-9. It is unclear if this printing information is referring to the printing information recited in lines 21-22 of claim 1 or lines 18-19 of claim 1.

**With respect to claim 3**, it recites the limitation of "inputted image information" in line 6. It is unclear if this limitation is referring to the image information recited in lines 2-3, line 10 or line 12? Or are they the same? If they are the same, would there ever be any differences among them? Which of them is not the inputted image information? Don't they have to be inputted first in a particular location in order to output, convert and store? Clarification/explanation from the Specification is respectfully requested.

Furthermore, Claim 3 recites the limitation of "said printing unit outputting the image information... as an image on the basis of the printing information" in lines 32-33. It is unclear if this printing information is referring to the printing information recited in line 11 or lines 27-28.

**With respect to claims 4 and 5**, arguments analogous to those presented for claim 2, are applicable.

**With respect to claims 6-8 and 12**, arguments analogous to those presented for claim 3, are applicable.

**With respect to claim 11**, arguments analogous to those presented for claim 1, are applicable.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 7, 8, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Mitsubori et al. U.S. Patent No. 7,283,267 (hereinafter Mitsubori).

**With respect to claim 1**, Mitsubori discloses an image printing system (fig. 1) which causes a printing unit (copying machine 11) to output an image on the basis of image information corresponding to a plurality of pages (fig. 13), comprising:

a printing information converting unit which converts image information into printing information (converting either web page image data or document image data into print data in order to print the pages in steps 407 & 415);

a storage unit which stores image information corresponding to a plurality of pages in advance (S403);

a difference comparison/detection unit which compares inputted image information corresponding to the plurality of pages stored in said storage unit on a page basis and detects differences between the inputted image information (web page image data) and the image information corresponding to the plurality of pages stored in the storage unit (document image data) on a page basis (S413 & S414); and

a control unit which controls said printing unit to output the printing information converted by said printing information converting unit, wherein page-based image information which is determined to be different by said difference comparison/detection unit is converted into printing information by said printing information converting unit, and said printing unit outputs the image information which is determined to be different by the difference comparison/detection unit as an image on the basis of the printing information (col. 10, lines 54-67).

**With respect to claim 7**, Mitsubishi discloses an image printing system (fig. 1) in which at least one information processing apparatus (web server 20) to which image information corresponding to a plurality of pages is input and an image printing apparatus (copying machine 11) including a printing unit which prints an image on the basis of the input image information corresponding to the plurality of pages are connected to each other through a network,

said image printing apparatus including:

a printing information converting unit which converts image information into printing information (converting either web page image data or document image data into print data in order to print the pages in steps 407 & 415);

a storage unit which stores image information corresponding to a plurality of pages in advance (S403);

a difference comparison/detection unit which compares inputted image information corresponding to the plurality of pages stored in said storage unit on a page basis and detects differences between the inputted image information (web page image

data) and the image information corresponding to the plurality of pages stored in the storage unit (document image data) on a page basis (S413 & S414); and

a control unit which controls said printing unit of said image printing apparatus to output the printing information converted by said printing information converting unit, wherein page-based image information which is determined to be different by said difference comparison/detection unit is converted into printing information by said printing information converting unit, and said printing unit outputs the image information which is determined to be different by the difference comparison/detection unit as an image on the basis of the printing information (col. 10, lines 54-57).

**With respect to claims 8, 11 and 12**, arguments analogous to those presented for claims 1 and 7, are applicable.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 4, 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsubori in view of Noble et al. U.S. Patent No. 5,978,842 (hereinafter Noble).

**With respect to claim 3**, as addressed in claims 1 and 7, Mitsubori discloses a printing apparatus including a printing information converting unit, storage unit, a difference comparison/detection unit and a control unit. Mitsubori, however, does not



explicitly disclose that the recited units are incorporated into the information processing apparatus.

Noble discloses an image processing system (fig. 5) comprising:

a storage unit (the client applicant's database in col. 8, lines 10-12) which stores image information corresponding to a plurality pages in advance (archiving documents in the database in advance in col. 8, lines 25-29); and

a difference comparison/detection unit which compares input image information corresponding to a plurality of pages (fresh copy of the web-page documents fetched from the server 12 in col. 8, lines 13 & 25-26) with the image information corresponding to the plurality of pages stored in said storage unit on a page basis (comparing the two documents to detect any changes in the web-page in col. 8, lines 25-38),

wherein page-based image information which is determined to be different by said difference comparison/detection unit is stored in the storing unit (storing/updating the client's database with the recent document in col. 8, lines 61-64).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the information processing apparatus (web server 20) of Mitsubori to incorporate the recited units as taught by Noble.

The suggestion/motivation for doing so would have been to provide the difference comparison/detection function in the information processing apparatus to increase the processing speed at the printing apparatus.

Therefore, it would have been obvious to combine Mitsubori with Noble to obtain the invention as specified in claim 3.

**With respect to claim 4**, refer to fig. 13 of Mitsubori for said comparison.

**With respect to claim 6**, arguments analogous to those presented for claim 3, are applicable.

**With respect to claim 9**, refer to S407 & S415 of fig. 13.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsubori as applied to claim 1 above, and further in view of Miyoshi et al. U.S. Patent Pub. No. 2001/0049703 (hereinafter Miyoshi).

**With respect to claim 2**, Mitsubori discloses a system according to claim 1, but it does not explicitly disclose the system wherein when image information corresponding to the plurality of pages is to be output onto one output paper sheet, all the page-based image information including the page-based image information which is determined to be different by said difference comparison/detection unit is converted into printing information by said printing information converting unit, and an image is output from said printing unit of said image printing apparatus on the basis of the printing information.

Miyoshi discloses an image printing system (fig. 9) wherein when web data including a plurality of pages is to be output onto one output paper sheet (printing the web data in 2-sided in fig. 9), the web data of the plurality of pages is converted into printing information by a converting unit (converting the web data into the imaging data for printing in paragraph 75), and an image is output from a printing unit of a printer on

the basis of the converted printing information (printing the converted data according to paragraph 79).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the image printing system of Mitsubori to incorporate the 2-sided function for printing the revised/updated web data as taught by Miyoshi.

The suggestion/motivation for doing so would have been to save the paper by using the 2-sided function in printing.

Therefore, it would have been obvious to combine Mitsubori with Miyoshi to obtain the invention as specified in claim 2.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Mitsubori and Noble as applied to claim 3 above, and further in view of Miyoshi.

**With respect to claim 5**, the combination discloses a system according to claim 3, but it does not explicitly disclose the system wherein when image information corresponding to a plurality of pages is to be output onto one output paper sheet, all the page-based image information including page-based image information which is determined to be different by said difference comparison/detection unit is converted into printing information by said printing information converting unit, and an image is output from said printing unit of said image printing apparatus on the basis of the converted printing information.

Miyoshi discloses an image printing system (fig. 9) wherein when web data including a plurality of pages is to be output onto one output paper sheet (printing the web data in 2-sided in fig. 9), the web data of the plurality of pages is converted into printing information by a converting unit (converting the web data into the imaging data for printing in paragraph 75), and an image is output from a printing unit of a printer on the basis of the converted printing information (printing the converted data according to paragraph 79).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the image printing system of Mitsubori and Noble to incorporate the 2-sided function for printing the revised/updated web data as taught by Miyoshi.

The suggestion/motivation for doing so would have been to save the paper by using the 2-sided function in printing.

Therefore, it would have been obvious to combine three references to obtain the invention as specified in claim 5.

**With respect to claim 10**, arguments analogous to those presented for claim 5, are applicable.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CHAN S. PARK** whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Edward L. Coles/  
Supervisory Patent Examiner, Art Unit 2625

/CHAN S PARK/  
Examiner, Art Unit 2625

September 4, 2008